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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,175	10/14/2004	Noriyoshi Satoh	37107	1995
116	7590	07/27/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			BALAOING, ARIEL A	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/511,175	Applicant(s) SATO ET AL.	
	Examiner Ariel Balaoing	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "almost" in claim 2 is a relative term which renders the claim indefinite. The term "almost" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

4. The term "almost" in claim 4 is a relative term which renders the claim indefinite. The term "almost" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by NUOVO et al (US 2004/0077391).

Regarding claim 1, NUOVO discloses a portable terminal comprising (abstract): a battery attachment portion to which a detachable battery is attached (85-Figure 8; paragraph 74); an information recording medium storage portion (80-Figure 8; paragraph 74) for detachable storing an information recording medium in which information is recorded toward a battery attachment portion side (paragraph 74), the information recording medium storage portion being disposed in adjacent to the battery attachment portion (Figure 8; paragraph 74); and a battery housing portion, for storing the battery, which is constituted by the battery attachment portion and the information recording medium storage portion (87-Figure 8; paragraph 74), both an outer face of the battery and an outer face of the information recording medium being covered with a cover member (paragraph 74), wherein one major surface of the information recording medium is exposed when the cover member is detached from the battery housing portion (Figure 8; paragraph 74).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the information recording medium storage portion and an input/output [keypad/display] portion for inputting and outputting information are disposed in an overlapped manner at a side of the information recording medium opposite to a surface of the information recording medium being exposed (Figure 1; paragraph 41-47).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over NUOVO et al (US 2004/0077391) in view of KIM (US 6,681,120 B1).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the battery housing portion is provided in a housing of an almost rectangular parallelepiped (85-Figure 8). However, NUOVO does not disclose a second information recording medium storage, for storing in a detachable manner an information recording medium. KIM discloses a second information recording medium storage, for storing in a detachable manner an information recording medium (abstract). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a connector that allows the means for accessing a secondary detachable memory, as taught by KIM, as both inventions relate to portable device construction. This is beneficial in that it allows the invention of NUOVO to include both a subscriber based memory module as well as a larger memory type for holding multimedia files. However, the combination of NUOVO and KIM does not disclose wherein the second information recoding medium storage portion is disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing. The

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combination of NUOVO and KIM discloses the claimed invention except for wherein the second information recoding medium storage portion is disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a portable device to include a second information recoding medium storage portion disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the housing includes: a first housing (paragraph 15); a second housing (paragraph 15); and a hinge portion for coupling the first housing and the second housing in a manner capable of being folded (paragraph 15; a clam shell design with a two or more part arrangement able to be rotated relative to each other is disclosed; a first housing, second housing and hinge is inherently necessary when a portable device is designed in such a way).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the information recoding medium has an almost rectangular parallelepiped shape (80-figure 8; 81-figure 13; paragraph 74), and wherein the information recording medium coincides with a direction orthogonal to the longitudinal direction of the housing (80-figure 8). However, NUOVO does not disclose wherein the second information recoding medium has an

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almost rectangular parallelepiped shape, wherein the second information recording medium storage portion is disposed in a manner that a longitudinal direction of the second information recording medium coincides with the longitudinal direction of the housing. KIM discloses wherein the second information recording medium has an almost rectangular parallelepiped shape (200-Figure 1), wherein the second information recording medium storage portion is disposed in a manner that a longitudinal direction of the second information recording medium coincides with the longitudinal direction of the housing (Figure 1; column 2:lines 10-45). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of NUOVO to include a second information medium and a second information storage portion, as taught by KIM, as both systems relate to the design of a mobile device. This is beneficial in that it allows the invention of NUOVO to include both a subscriber based memory module as well as a larger memory type for holding multimedia files.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, NUOVO does not disclose wherein the housing has an opening portion for storing the second information recording medium within the second information recording medium storage portion, and wherein the opening portion is covered by an open/close lid in a manner that the lid moves in a direction orthogonal to a housing direction of the second information recording medium and rotates in a freely closing and opening manner with respect to the housing. KIM discloses wherein the housing has an opening portion for storing the second information

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recording medium within the second information recording medium storage portion (120A-Figure 1), and wherein the opening portion is covered by an open/close lid in a manner that the lid moves in a direction orthogonal to a housing direction of the second information recording medium and rotates in a freely closing and opening manner with respect to the housing (150, 152, 154-Figure 4). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include an opening in the case for a memory card with a protective covering, as taught by KIM, as both inventions relate to mobile terminal design. This is beneficial in that it allows a secure external method of memory card insertion.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

BOAKES et al (US 2002/0090842) – Connector supporting one or more removable storage mediums

CHOU (US 2003/0038791 A1) – SIM Card backup system

SAKAGUCHI et al (US 6,892,078 B2) – SIM Card mounting structure

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing
Art Unit 2683
Patent Examiner

AB


RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
7/25/08